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DAVID EDWARDS
INTELLECTUAL PROPERTY SECTION
HERCULES INCORPORATED HERCULES PLAZA
WILMINGTON DE 19894-0001

EXAMINER

VENKAT, J

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 04/24/00

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 15

Application Number: 08/855,779
Filing Date: 5/12/97
Appellant(s): MODI

DAVID EDWARDS
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 11/29/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the

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pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-44 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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4,845,207	t'SAS	4-1989
4,902,733	ANGERER	2-1990
4,904,772	SAU	2-1990

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,902,733 ('733).

Patent '733 discloses a composition comprising a rheology modifier which is a non-ionic, water soluble 3-alkoxy-2-hydroxy propyl hydroxyethylcellulose polymer. The alkyl moiety may be a straight or branched chain alkyl group having 6-24 carbon atoms . The composition . See col.1 lines 65 through col.2 , line 12 . See col.3 , lines 58-60 for the surfactant and the potassium compound is the zwitterionic surfactant . See col.4 , lines 9-10 and see the examples for " water and propylene glycol " which is the solvent . Titanium dioxides are pigments which is the claimed personal care ingredient as pigments are used in make-up products and lipsticks . The preamble does not carry any patentable weight as the claims are drawn to the compositions.

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Claims 1, 8-9 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,845,207 ('207).

Patent '207 discloses a composition comprising 3-alkoxy-2-hydroxy propyl hydroxyethylcellulose where in the alkyl moiety is straight or branched chain alkyl group containing 1-10 carbon atoms . The composition may include other components such as plasticizer , solvents , preservatives etc . Plasticizer reads on the personal care ingredient as plasticizer are use din manicure compositions . See col.2 , lines 9-26 , col.4 , lines 16-23 . The phrase “ personal care compositions “ carry no patentable weight . Titanium dioxides are pigments which is the claimed personal care ingredient as pigments are used in make-up products and lipsticks . The preamble does not carry any patentable weight as the claims are drawn to the compositions.

Claims 1-8 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,904,772 ('772).

The patent '772 discloses a composition comprising a rheology enhancer which is a non-ionic water -soluble 3-alkoxy-2-hydroxy propyl hydroxyethylcellulose polymer . The composition may also comprise surfactants and solvents such as propylene glycol . See col.2 , lines 1-8 , lines 42-62 . See col.7 , lines 5-13 . See table 3 , and see col.10 , line 11 . Titanium dioxides are pigments which is the claimed personal care ingredient as pigments are used in make-up products and lipsticks . The preamble does not carry any patentable weight as the claims are drawn to the compositions.

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Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 4, 904,772 ('772).

The patent discloses the claimed compound along with the personal care ingredients . See the relevant portions outlined in 102(b) rejections . The patent does not disclose the claimed features like conditioner , shampoo , sun care , shower gel , soap etc . The patent teaches that the polymers are useful as thickeners in shampoos and cosmetics . Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the compositions in the above listed formulations as it is well known in the “ personal care ‘ industry to utilize thickeners , solvents , surfactants . No patentable distinction is seen in the use of an old composition in various personal care formulations , absence of any evidence of criticality .

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(11) Response to Argument

Appellants argue that patent '733 is directed to solely to an aqueous protective compositions that is non-analogous field from personal care compositions and the claims have been amended to recite that the personal care ingredients is "active personal care ingredient" which is defined at pages 6-7 and examples 8-30.

The claims are drawn to the compositions . The patent discloses the claimed polymer . The Honorable Board's attention is drawn to page 7 of the specification . The specification discloses " *pigments* " as the active personal care ingredient . The patent at col.3, line 54 discloses " *pigments* " . Therefore the claims are anticipated within the meaning of 35 U.S.C. 102 (b) . A chemical compound and its properties are inseparable . See *In re Spada 15 USPQ 2nd 1655, 1658* .

Appellants argue that " opacifying pigments " like titanium dioxide are powders or clays that are fine for paints but would not be used in hair care treatments .

The specification at page 7 , under category 9 discloses the active personal ingredient as " pigments " . Titanium dioxide disclosed in the patent belongs to the class of *pigments* .

Appellants argue that the patent '772 discloses a mixed hydrophobic polymer with at least 2 hydrophobic radicals where one can be 3-alkoxy-2-hydroxy propyl moiety and the other has to be at least two carbon atoms longer than the first .

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The claims are drawn to the polymer where the hydrophobic radical can be mixtures of the alkyl group . See the claim recitation “ alkyl---mixtures thereof “ The backbone claimed is same to that disclosed in the patent . Therefore the polymer is the same claimed broadly .

Appellants point out that although the patent discloses at col.10 , line 11 that the polymers can be used in cosmetics and shampoos , there is no working examples or how to make the cosmetics or shampoos .

The patent is valid for the entire disclosure and not limited to working examples . The patent discloses that the polymers are useful in cosmetics and shampoos and the patent discloses pigments which is the claimed active personal ingredient .

Appellants urge that the patent ‘207 is directed to the building compositions and there is no disclosure in the patent for appraising a person skilled in the art on how to use the compositions for personal care compositions .

The patent discloses under table 1 various “ butoxy “ polymers . Appellants use the same polymer in the examples . The patent discloses preservatives and plasticizers at col. 4 , lines 16-20 . The “ *preservatives* “ belong to the claimed “ personal care ingredient” . See page 8 of the specification at line 25 . The claims are drawn to the compositions and the preamble does not carry any patentable weight .

Appellants urge that the components disclosed at col.4 like “ plasticizer , surface active agents “ are taught for use in building materials and although they may have many uses in different industries , they are not the “ **active ingredients**” that appellants have defined .

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Limitation of the specification can not be read in to the claims . See *In re Prater* 162 USPQ 541. The patent discloses " preservatives " at col.4 and the specification defines at page 7 , line 25 " preservatives " as the active ingredient .

Appellants argue that the arguments presented set forth above regarding '772 is repeated and it is not obvious to one of ordinary skill in the art to make the instant personal care compositions .

The patent discloses the polymers as useful in cosmetics and shampoos . One of ordinary skill in the art would be certainly motivated to use the same polymers in the various personal care formulations expecting the polymers to exhibit enhanced rheological properties .The claims are obvious within the meaning of 35 U.S.C. 103 .

For the above reasons, it is believed that the rejections should be sustained.

JV
April 21, 2000

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